UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,533	01/26/2001	Madoka Mitsuoka	1405.1033/JDH	4908

21171 7590 10/12/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ROSEN, NICHOLAS D	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/769,533	MITSUOKA ET AL.	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 5-10* is/are rejected.

7)☒ Claim(s) *2-4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 March 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-10 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 10 is rejected under 35 U.S.C. 102(a) as being anticipated by the anonymous article, "Omaha, Neb.-Based Start-Up Firm to Offer Online Grocery Service," hereinafter "Omaha." "Omaha" discloses a method for processing for delivery of an item, comprising: accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item after the item has been ordered, and wherein the delivery terms comprise a date and time of delivery (three paragraphs beginning from, "For consumers, the venture into the virtual supermarket").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5, 6, and 7

Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of Bjorner ("Shop Online for Holiday Food") and official notice; claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of Bjorner. As per claim 1, Buettgenbach discloses a method for managing delivery of products that have been ordered, including: presenting a screen which accepts delivery applications of the products to a provider of the products, and accepting applications for delivery of said products from the provider of said products (paragraphs 31, 37, and 38; Figure 1); assigning application ID's to said applications (paragraphs 15, 49, 103, and 104); presenting a screen which notifies a delivery recipient of the product, and accepting a designation of delivery terms (paragraph 38; the disclosure of using a Web site and Web browser makes a screen obvious); and presenting said delivery recipient with a screen displaying at least a product scheduled to be delivered to said delivery recipient (paragraph 48).

Buettgenbach does not expressly disclose a presenting step of presenting said delivery recipient with a list of the products scheduled to be delivered to said delivery recipient and said application ID, although this can be considered as disclosed if a list with one item is still a list (paragraph 48). However, the duplication of known parts is held to be obvious to one of ordinary skill in the art (*St. Regis Paper Co. vs. Bemis Co.*, 193 USPQ 8, 11; 549 F. 2nd. 833 (7th Circuit 1977); *In re Harza*, 124 USPQ 378, 380; 274 F. 2nd. 269, CCPA (1960)). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to present said delivery recipient a list of products scheduled to be delivered, for the obvious advantage of making arrangements for delivery when more than one product was involved.

Buettgenbach discloses presenting a screen which accepts designation of delivery terms for the applications from the recipient (in the case when the buyer is the recipient; see paragraph 38), and accepting designation of delivery terms on the screen from the delivery recipient after orders of the products (paragraphs 31, 37, and 38; Figure 1); and discloses presenting information on the products for which delivery terms have been designated, the designated delivery terms, and the delivery recipient to a delivery business being specified by the designated delivery terms (paragraph 40). Buettgenbach does not expressly disclose presenting a screen displaying this information, but does disclose sending a message which can be e-mail (paragraph 40). Official notice is taken that it is well known to view e-mail messages on screens; hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to present a screen displaying the products, etc., for the

obvious advantage of enabling employees of the delivery business to read the e-mail and take appropriate action.

Buettgenbach does not disclose that the delivery terms comprise a date and time of delivery, but Bjorner teaches a delivery recipient specifying delivery terms comprising a date and time (three paragraphs beginning from, "Using Peapod, you can construct"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the delivery terms to comprise a date and time of delivery, for such obvious and implied advantages as making the delivery of groceries in time for a dinner-party, or making the delivery at a time when the recipient will be at home.

As per claim 6, Buettgenbach discloses judging whether said delivery recipient is the party that ordered said product(s) (paragraphs 77 and 84); and accepting cancellations of orders for said identified products (paragraphs 83 through 88); and notifying the provider of said products for which the specified order by said application has been cancelled, according to a result of said judging (paragraph 88).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613), Bjorner ("Shop Online for Holiday Food"), and official notice as applied to claim 1 above, and further in view of Mandler (U.S. Patent 5,732,400). Buettgenbach discloses a judging step of judging whether said delivery recipient is the party that ordered said product(s) (paragraph 77). Buettgenbach does not disclose notifying the provider of said products that the products specified by said application ID's have been purchased after said term

accepting step, according to a result of said judging, but it is well known to notify product providers that products have been purchased, as taught, for example, by Mandler (column 3, lines 48-65; column 4, lines 20-42). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to notify the provider as claimed, for the obvious advantage, as taught in Mandler, of arranging for the shipping and delivery of ordered products.

Claim 7 is closely parallel to claim 1, and rejected on essentially the same grounds, except that claim 7 does not recite presenting screens, so official notice that it is well known to present screens is not requisite in regard to claim 7.

It is noted that claim 7 uses "means for" language. Nonetheless, it is not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claims 8 and 9

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of Hartman et al. (U.S. Patent 5,960,411), Walker et al. (U.S. Patent 5,862,223), and Bjorner ("Shop Online for Holiday Food"). Buettgenbach discloses a delivery

information service method, including: receiving a delivery request for an article (paragraph 31, 37, and 38). Storing a received delivery request in a storage device is inherent from further manipulation of the request data (e.g., paragraphs 51 and 52). Buettgenbach does not disclose searching a storage device for pending deliveries with the same delivery recipient as the delivery recipient of said delivery request, but Hartman teaches combining orders to be sent to the same recipient into multiple-item orders, implying search of pending deliveries to enable relevant orders to be found and combined (column 8, lines 27-55; column 8, lines 1-25). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to search the storage device for pending deliveries with the same delivery recipient, for the stated advantage of minimizing shipping costs and purchaser confusion, and for the obvious advantage of arranging for delivery recipients to make fewer trips to pick up available products from Buettgenbach's Will-Call Centers.

Buettgenbach does not expressly disclose referring to an address table and extracting the notification address of the delivery recipient, but it is well known to maintain files of people's addresses, and extract the addresses therefrom, as taught, for example, by Walker (Figure 12; column 24, lines 6-21). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to refer to an address table and extract the notification address therefrom, for the obvious advantage of delivering the article or articles to the correct address.

Buettgenbach discloses that, based on desired delivery terms, instructions are made for delivery to the delivery recipient of the article scheduled for delivery, said instructions being given to a delivery business that has been designated by the desired conditions or that matches desired conditions (paragraph 40).

Buettgenbach does not disclose that the delivery terms comprise a date and time of delivery, but Bjorner teaches a delivery recipient specifying delivery terms comprising a date and time (three paragraphs beginning from, "Using Peapod, you can construct"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the delivery terms to comprise a date and time of delivery, for such obvious and implied advantages as making the delivery of groceries in time for a dinner-party, or making the delivery at a time when the recipient will be at home.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613) in view of Hartman et al. (U.S. Patent 5,960,411) and Walker et al. (U.S. Patent 5,862,223). Claim 8 recites, in essence, a computer program for carrying out the method of claim 9, and is therefore rejected on essentially the grounds set forth above with regard to claim 9.

Claim 10

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article, "Webvan.com Debuts as Online Grocery and Drug Megastore in the San Francisco Bay Area," hereinafter "Webvan.com," in view of Hartman et al. (U.S.

Patent 5,960,411). "Webvan.com" discloses a method for processing for delivery of an item, comprising: accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item, and wherein the delivery terms comprise a date and time of delivery (whole article, especially three paragraphs beginning from, "Using Peapod, you can construct"). "Webvan.com" does not expressly disclose that the item has been ordered, although the language can be read as indicating that the item has been ordered, or at least selected to be ordered, but it is well known to provide delivery information after an item has been ordered, or at least selected for ordering, as taught, for example, by Hartman (column 1, lines 46-65); hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the item to have been ordered, for the obvious advantage of arranging for the delivery of ordered items.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorner ("Shop Online for Holiday Food") in view of Hartman et al. (U.S. Patent 5,960,411). Bjorner discloses a method for processing for delivery of an item, comprising: accepting at a computer delivery terms of the item wherein said delivery terms are entered by a prospective recipient of the item, and wherein the delivery terms comprise a date and time of delivery (whole article, especially three paragraphs beginning from, "Using Peapod, you can construct"). Bjorner does not expressly disclose that the item has been ordered, although the language can be read as indicating that the item has been ordered, or at least selected to be ordered, but it is well known to provide delivery information after an item has been ordered, or at least selected for ordering, as taught,

for example, by Hartman (column 1, lines 46-65); hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the item to have been ordered, for the obvious advantage of arranging for the delivery of ordered items.

Allowable Subject Matter

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and further amended to overcome the objection set forth above.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Buettgenbach et al. (U.S. Patent Application Publication Application Publication 2002/0032613), discloses or makes obvious the limitations of claim 1, as set forth above, with the limitation that the delivery terms comprise a date and time of delivery taught by Bjorner ("Shop Online for Holiday Food"), and by other prior art. However, neither Buettgenbach nor any other prior art of record discloses, teaches, or reasonably suggests a group accepting step of accepting formation of a group and designation of group members from said delivery recipients; and said presenting of a notification screen further including a group notification step of giving notification of a list of products scheduled for delivery to other members of the group to which the delivery recipient belongs, and the application ID's therefor. Buettgenbach does disclose designating an alternative recipient to pick up ordered

product(s) (paragraph 38); it is known to accept formation of a group and notify the members of such a group (e.g., forming an e-mail list, and sending a post to all members of such a list), and it is known to leave a message and/or a package with a neighbor if the intended recipient of a package isn't available when the deliveryman comes by, but these do not suffice to teach the recited limitations.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Buettgenbach et al. (U.S. Patent Application Publication 2002/0032613), discloses or makes obvious the limitations of claim 1, as set forth above, with the limitation that the delivery terms comprise a date and time of delivery taught by Bjorner ("Shop Online for Holiday Food"), and by other prior art. Buettgenbach does not expressly disclose that said application accepting step further includes a step of accepting an application for delivery of a first product of said products and an application for delivery of a second product of said products, with corresponding first and second delivery terms, but it is well known to order multiple products. However, Buettgenbach does not disclose a judging step of judging whether prior to delivery of the first product, a second delivery term is designated for the second product; and a term changing step of changing the first delivery term set for the first product to the second delivery term set for the second product according to a result of

the judging step (nor the slightly different limitations of claim 4). No other prior art of record discloses, teaches, or reasonably suggests these limitations. The closest prior art for these limitations is Kawasaki (Japanese Published Patent Application 11-272752 A), and Kawasaki, although related to the modification of delivery dates, does not teach the limitations recited in either claim. It would be surprising if no one had thought to deliver two products to the same recipient together, even if they might otherwise have been delivered at the same time, but doing so is not held to meet the detailed limitations of claims 3 or 4.

Response to Arguments

Applicant's arguments filed August 4, 2006, have been fully considered but they are not persuasive. Applicant's arguments, particularly regarding claim 10, are in part mooted by the new prior art applied in response to applicant's amendments. With regard to claim 1, Applicant argues that Buettgenbach does not disclose or suggest the feature of the delivery terms comprising a date and time of delivery, and that in Buettgenbach, the delivery recipient is notified by the community pickup center when the package has arrived, as opposed to the delivery recipient designating the date and time of delivery. Examiner replies that other prior art references, notably Bjorner, do teach a delivery recipient designating the date and time of delivery, and that this is not incompatible with the system and method of Buettgenbach, since a customer might want to specify the date and time of delivery to a community pickup center; furthermore, although in Applicant's description of the currently claimed invention, the delivery may

be made to the private residence of the buyer, this is not a claim limitation. It may also be observed that claim 7 does not recite that all the means must be operated by the same entity.

Applicant argues that there is no motivation to combine Buettgenbach and Mandler to find claim 5 obvious; the motivation taught in Mandler, of arranging for the shipping and delivery of ordered products, is alleged to be unreasonable because the original order in the method of Buettgenbach is placed through the product provider. Examiner replies that this need not conflict with the step of notifying the provider that the products have been purchased, after the step of accepting delivery terms and according to judging whether the delivery recipient is the party that ordered the products. First, the provider's server computer might notify the provider after accepting delivery terms and judging the authenticity of the customer placing the order. Secondly, a deliveryman, upon delivering products to the customer (which would happen after accepting delivery terms), might judge whether the delivery recipient was the party that ordered the products (for example, by asking to see a photo ID), and then notify the provider.

Applicant further argues, with regard to claims 8 and 9, that there is no motivation to combine the features of Walker and Hartman with the system and method of Buettgenbach. Specifically, Applicant argues that Buettgenbach teaches away from the combination with Walker's element of maintaining files of people's addresses, and extracting the addresses therefrom, because Buettgenbach discloses a system for delivering products to community pickup centers, rather than home addresses. Examiner replies that there would still be motivation to find the address of the

appropriate community pickup center, so as to deliver the product to the correct community pickup center.

Applicant argues that Buettgenbach teaches away from the combination with Hartman's element of combining orders to be sent to the same recipient into multiple-item orders, invalidating Examiner's statement of motivation, "for the stated advantage of minimizing shipping costs and purchaser confusion, and for the obvious advantage of arranging for delivery recipients to make fewer trips to pick up available products from Buettgenbach's Will-Call Centers." Examiner replies that the motivation of minimizing shipping costs would still apply, because it could well cost more to send multiple packages to the Will-Call Center separately. The stated advantage of minimizing purchaser confusion could also still apply, because a purchaser might be uncertain as to whether a notification indicated that one of several products had arrived at the Will-Call Center, or that they all had, and such uncertainty might lead to a purchaser making additional trips to pick up available products from Buettgenbach's Will-Call Centers, the final motivation given. (It has not escaped Examiner that notifications to customers ought to be correct and unambiguous, but Examiner is familiar enough with life's imperfections to observe that erroneous notifications to purchasers might be sent, or that purchasers, upon receiving notification that item #1234 had arrived at a Will-Call Center, might wonder whether item #1235 had arrived as well, even if item #1235 had not been explicitly mentioned.)

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lockwood (U.S. Patent 5,576,951) discloses an automated sales and services system, wherein a customer may enter a specific time of day for a delivery (see the last paragraph in column 21). Florence (U.S. Patent 2002/0007299) discloses a method and system of delivering items using overlapping delivery windows.

The anonymous article, "College Takeout Online," discloses enabling students to order food, and indicate the delivery date and time, inter alia.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
October 10, 2006